

Serial No. 10/629,063
Docket No. 200309257-1

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed November 30, 2007, in which claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 were rejected under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent Publication No. 2003/0025321 A1 (hereinafter "Lee").

It is respectfully submitted that the presently pending claims be examined and allowed.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 under 35 U.S.C. § 102(c) as being anticipated by Lee. Applicants assert that Lee does not disclose Applicants' invention, because Lee fails to disclose the elements and arrangement thereof required by the present claims.

The presently pending claims set forth a print medium having a data storage device in or on only a portion of the print medium. Lee, on the other hand, teaches a print medium that includes a magnetic layer that is the same size of the ink receptive layer. Therefore, the boundaries of the magnetic layer and of the ink receptive layer(s) are entirely coincident. See, e.g. Fig. 2. Such a device cannot be reasonably said to have any relation to "only a portion of" the print medium. More specifically, the magnetic layer of Lee is not situated in only any portion of the print medium ... rather, the magnetic layer is clearly inside all of the print medium. As Applicants have asserted, one cannot consider such an arrangement as "in only a portion of" the print medium without realizing this to mean that there would be no way for the magnetic layer to be in more than a portion of the medium and still be only a component of the medium. For the magnetic layer of Lee to be in only a portion of the medium disclosed therein, and therefore read on the present claims, its boundaries would have to encompass a smaller area than that of the print medium. Stated in different terms, there would have to be some portion of the medium where one may traverse the interior of the medium without encountering a magnetic layer. This is clearly not possible in the structure disclosed in Lee. Therefore, the magnetic layer in Lee does not reside in only a portion of the print medium. With regard to the other possibility recited in

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the present claims, the magnetic layer in Lee is not on any portion of the print medium. To be on any portion of the medium, the layer would have to be outside the medium, which it clearly is not. Therefore, the magnetic layer of Lee cannot anticipate a device of the present claims that is on the print medium.

Applicants note that many of the rejections in this and previous Office Action cite para [0028] of Lee as a teaching of a magnetic strip in accordance with the present invention. Applicants must again assert that Lee does not disclose Applicants' invention simply by mentioning a magnetic strip without any teaching of its relationship to any other elements of the invention. To do so, Lee would have had to disclose the elements of the claim as arranged in the claim. There is no evidence of any teaching in Lee of the claimed arrangement of all elements. As Applicants have asserted, the cited text is at most an isolated mention of a possible element which could be situated in any number of collocations of other elements. To consider this as anticipation under § 102 would be to allow the selective picking of any isolated word(s) in a reference in order to assemble an anticipatory teaching. Applicants believe that requirements set forth in MPEP 2131, e.g. the "identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim," do not permit such use of references under § 102. As such, Applicants assert that Lee does not anticipate the present invention under any section of 35 U.S.C. § 102, and respectfully request withdrawal of the rejection.

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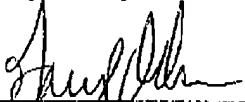
CONCLUSION

In light of the above, Applicant respectfully submits that the pending claims are in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains, the Examiner is strongly encouraged to call Gary Oakeson at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 29th day of January, 2008.

Respectfully submitted,



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